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*708*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/367,040 08/06/99 BROWNFIELD

A MERCK2009

EXAMINER

023599 IM52/0618  
MILLEN, WHITE, ZELAND & BRANIGAN, P.C.  
2200 CLARENDON BLVD.  
SUITE 1400  
ARLINGTON VA 22201

AHMED, S

ART UNIT

PAPER NUMBER

*11*

1773

DATE MAILED:

06/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/367,040

Applicant(s)  
Brownfield et al.

Examiner  
Sheeba Ahmed

Art Unit  
1773



– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 6, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-9, and 11-14 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9, and 11-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Response to Amendment*

1. Amendments to Claims 1-5 and 7-9 have been entered in the above-identified application. Claims 6 and 10 have been canceled. New claims 11-14 have been added.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### *Claim Rejections - 35 USC § 102*

2. Claims 1-4, 9, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 4238378 A.

DE 4238378 A discloses coating a substrate such a paper (*equivalent to the laser-markable paper of the claimed invention*) with a pigmented lacquer formulation coating (*thus meeting the limitation of claim 9*) pearlescent pigments based on metal-oxide coated mica flakes (*equivalent to the pearl luster pigment of the claimed invention*) wherein the flakes have a particle size of less than 20 microns (*thus meeting the limitation that the particle size is between 1 and 60 microns*) are present in the lacquer at a concentration of 2-6 wt.% (See Abstract). The coated papers are used in packaging and for decorative purposes (*thus meeting the limitation of claim 14*). The Examiner takes the position that the coated paper and the filler disclosed in DE 4238378 A are inherently laser-markable and electrically conductive, respectively,

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given that the composition and structure of the coated paper and the filler disclosed in DE 4238378 A is identical to the paper and filler of the claimed invention. All limitations of the claimed invention are either inherent or disclosed in the above reference.

3. Claims 1, 7, 9, and 11-13 rejected under 35 U.S.C. 102(b) as being anticipated by Gusi (US 5,773,494).

Gusi discloses a laser beam absorbing resin composition which is adaptable for laser marking and includes titanium dioxide in the range of 1.5 to 5wt.% (*equivalent to the absorber material of the claimed invention*) (Column 2, lines 37-47). The titanium dioxide has an average particle size of 0.01 $\mu$ m to 10 $\mu$ m (*thus meeting the particle size limitation*) (Column 3, lines 15-25). The coating may be applied to any desired surface such as paper (*thus resulting in a laser markable paper*) and further contains additives such as other colorants and inorganic fillers (Column 3, lines 59-54). All limitations of the claimed invention are disclosed in the above reference.

4. Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gusi (US 5,773,494) in view of Williams (US 5,206,280).

Gusi, as discussed above, disclose the claimed invention but do not specifically state that the coated layer comprises a mixture of absorber material. Williams, however, discloses a laser markable coating which includes a first pigment markable by laser such as titanium dioxide and a

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second pigment which is nonabsorbing in the UV region and has a white appearance (Column 1, lines 61-67). The coating may be used to coat paper (Column 2, lines 51-56). Accordingly, it would have been obvious to one having ordinary skill in the art to add a second pigment absorber material to the laser markable coating disclosed by Gusi given that Williams specifically teaches that doing so increases the optical density of the coating and thus has a whitening effect without adversely affecting the laser markability of the composition.

#### *Response to Arguments*

5. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. However, the Examiner would like to address Applicants argument that DE 4238378A discloses carbon black as the suitable pigment whereas the instant invention requires that the absorber material have a very pale intrinsic color and be required in small amounts. First, the Examiner would like to point out that DE 4238378 A discloses a pigmented lacquer formulation coating having pearlescent pigments based on metal-oxide coated mica flakes (*i.e., does not require the presence of carbon black*) wherein the flakes have a particle size of less than 20 microns and are present in the lacquer at a concentration of 2-6 wt.%. Second, the limitations that the Applicants relies upon (*i.e., the absorber material have a very pale intrinsic color*) are not stated in the claims. It is the claims that define the claimed invention and it is the claims that are unpatentable.

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*Conclusion*

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (703) 305-0594. The Examiner can normally be reached on Monday-Friday from 8am to 5pm. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5436.

*SA*  
Sheeba Ahmed  
June 14, 2001

*Paul Thibodeau*  
Paul Thibodeau  
Supervisory Patent Examiner  
Technology Center 1700